

REMARKS

Claims 1, 3, 5-6, 8, 11-12 and 18 are pending in this application. Claims 2, 4, 7, 9-10 and 13-17 have been canceled without prejudice or disclaimer. Claims 1, 3, 5-6 and 8 have been amended. Claim 18 has been newly added.

Claims 2, 4, 7, 9-10 and 13-17 have been canceled without prejudice or disclaimer, and claims 1, 3, 5-6 and 8 have been amended, for the sole reason of advancing prosecution. Applicants, by canceling or amending any claims herein, make no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicants reserve the right to reassert any of the claims canceled herein or the original claim scope of any claim amended herein, in a continuing application.

Claim 1 has been amended to recite a "cosmetic preparation for topical application onto skin of a subject, the preparation consisting of: Dead Sea mud; demagnetized nanoparticles dispersed therein and present in an amount of 1 to 20 wt%, the demagnetized nanoparticles being suitable for magnetization when applied to the skin of the subject; and optionally one or more cosmetically acceptable additives." Support for claim 1, as amended, can be found throughout the specification and claims as originally filed.

Claims 3, 5 and 6 have been amended to be in a form consistent with acceptable US practice. In particular, claims 3, 5 and 6 now recite proper Markush language in proper Markush format. Additionally, claims 3 and 6 have been amended to correct antecedent basis. Specifically, claims 3 and 6 now recite the phrase "cosmetic preparation," rather than "cosmetic compositions."

Claim 8 has been amended to recite the “cosmetic preparation according to claim 1, wherein the one or more cosmetically acceptable additives are selected from the group consisting of an antioxidant, a vitamin, a medically active agent, a chemotherapeutic agent, a radio therapeutic agent, a humidifier, a biocide, a pigment, a smell agent, an odorant, a colorant, a UV absorbent, a UV blockage agent, a polymer, a thickener, a co-solvent, an emulsifier, a surfactant, a salt, propylene glycol, glycerol, hydroxypropyl cellulose, distilled water, quaternium-18 hectorite, propylene carbonate, caprylic/capric triglyceride, sorbitan isostearate, petrolatum, synthetic lanolin, mineral oil, jojoba oil, myristyl myristate, butylenes glycol, propylene glycol, cetyl PEG/PPG-10/11 dimethicone, polyglyceryl-4-isostearate, isohexadecane, butyrospermum parkii, isopropyl myristate, phenoxyethanol, methylparaben, butylparaben, ethylparaben, propylparaben, glycerin, imidazolidinyl urea, ethylhexyl palmitate, glyceryl stearate, cetyl alcohol, PEG-40 stearate, sorbitan tristearate, dimethicone, fragrance, xanthan gum, hydroxyethyl cellulose, propylene, stearylalkonium chloride, lactic acid, oleyl alcohol, PEG-100 stearate, magnesium aluminum silicate, sodium laureth sulfates, ammonium lauryl sulfate, lauramide DEA, and a vegetable extract.” Support for claim 24, as amended, can be found throughout the specification and claims as originally filed.

Claim 18 has been newly added. New claim 18 recites the “cosmetic preparation according to claim 3, wherein the demagnetized nanoparticles are demagnetized strontium hexaferrite nanoparticles.” Support for new claim 18 can be found throughout the specification and claims as originally filed.

No new matter has been added.

In view of the remarks set forth below, further and favorable consideration is respectfully requested.

I. At page 2 of the Official Action, claims 1, 3, 5, 6, 8, 11, 12, 16 and 17 have been rejected under 35 USC § 112, first paragraph.

The Examiner asserts claims 1, 3, 5, 6, 8, 11, 12, 16 and 17 fail to comply with the written description requirement because the phrase “said demagnetized nanoparticles being present in a quantity greater than naturally found in Dead Sea mud,” recited in claims 1 and 17, constitutes new matter. Additionally, the Examiner asserts that the phrase “said demagnetized nanoparticles being in a quantity greater than 400ppm,” recited in claim 16, also constitutes new matter.

In view of the remarks set forth herein, the rejection of claims 1, 3, 5, 6, 8, 11 and 12 is respectfully traversed.

Applicants note that claims 16 and 17 have been cancelled without prejudice or disclaimer. Accordingly, Applicants submit that the rejection of claims 16 and 17 has been rendered moot.

Applicants respectfully submit that the rejection of claims 1, 3, 5, 6, 8, 11 and 12 has been obviated because claim 1 no longer recites the phrase “said demagnetized nanoparticles being present in a quantity greater than naturally found in Dead Sea mud.” As discussed, independent claim 1 has been amended to recite a “cosmetic preparation for topical application onto skin of a subject, the preparation consisting of: Dead Sea mud; demagnetized nanoparticles dispersed therein and present in an amount of 1 to 20 wt%, the demagnetized nanoparticles being suitable for

magnetization when applied to the skin of the subject; and optionally one or more cosmetically acceptable additives." Claims 3, 5, 6, 8, 11 and 12 depend, either directly or indirectly from claim 1.

In view of the foregoing, Applicants respectfully submit that claims 1, 3, 5, 6, 8, 11 and 12 fully comply with 35 USC § 112, first paragraph. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

II. At page 4 of the Official Action, claims 1, 3, 5, 6, 8, 11, 12, 16 and 17 have been rejected under 35 USC § 112, first paragraph.

The Examiner asserts claims 1, 3, 5, 6, 8, 11, 12, 16 and 17 are indefinite because because the phrase "said demagnetized nanoparticles being present in a quantity greater than naturally found in Dead Sea mud," is not clear. Additionally, the Examiner asserts that the phrase "said demagnetized nanoparticles being in a quantity greater than 400ppm," recited in claim 16, also is also indefinite.

In view of the remarks set forth herein, the rejection of claims 1, 3, 5, 6, 8, 11 and 12 is respectfully traversed.

Applicants note that claims 16 and 17 have been cancelled without prejudice or disclaimer. Accordingly, Applicants submit that the rejection of claims 16 and 17 has been rendered moot.

Applicants respectfully submit that the rejection of claims 1, 3, 5, 6, 8, 11 and 12 has been obviated because claim 1 no longer recites the phrase "said demagnetized nanoparticles being present in a quantity greater than naturally found in Dead Sea mud." As discussed, independent claim 1 has been amended to recite a "cosmetic preparation for topical application onto skin of a subject, the preparation consisting of:

Dead Sea mud; demagnetized nanoparticles dispersed therein and present in an amount of 1 to 20 wt%, the demagnetized nanoparticles being suitable for magnetization when applied to the skin of the subject; and optionally one or more cosmetically acceptable additives." Claims 3, 5, 6, 8, 11 and 12 depend, either directly or indirectly from claim 1.

In view of the foregoing, Applicants respectfully submit that claims 1, 3, 5, 6, 8, 11 and 12 fully comply with 35 USC § 112, first paragraph. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

III. At page 5 of the Official Action, claims 1, 3, 5, 6, 8, 11, 12, 16 and 17 have been rejected under 35 USC § 103(a) as being unpatentable over Maor et al. (WO 00/40255) in view of Zastrow et al. (US Patent No. 5,596,988) and in further view of Shiga Yoko (JP 4,108,710).

The Examiner asserts that it would have been obvious to use demagnetized magnetic particles which are magnetized for cosmetic application to the skin in the composition of Maor et al. and Zastrow. The Examiner further asserts that one would have been allegedly motivated to do so because the use of the magnetic particles of Zastrow in the form as taught by Shiga Yoko would allegedly result in the benefit of increased circulation to the skin.

In view of the remarks set forth herein, the rejection of claims 1, 3, 5, 6, 8, 11 and 12 is respectfully traversed.

Applicants note that claims 16 and 17 have been cancelled without prejudice or disclaimer. Accordingly, Applicants submit that the rejection of claims 16 and 17 has been rendered moot.

A proper case of obviousness under 35 U.S.C. §103, requires that the prior art, as a whole, must suggest the desirability of making the claimed combination and provide a reasonable expectation of success. See *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

The *Dow* court further held that “In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered for the person of ordinary skill is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.” The court in *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994), held that “A prior art reference may be said to *teach away* when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” The court in *Busch & Lamb, Inc. v. Barnes-Hind/Hydro curve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986), held that “A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered.”

To establish a *prima facie* case of obviousness, the Examiner must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to

combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” (*KSR*, 550 U.S. 398 at 417.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

Regarding motivation to modify properly combined references, **MPEP 2143** states that where the prior art conflicts, all teachings must be considered and that the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. **MPEP 2143** further states that there must be some suggestion or motivation to modify the references, and there must be a reasonable expectation of success. In addition, the prior art reference or references when properly combined, must teach or suggest all the claim limitations.

MPEP 2143.01 states that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. If it does, then there is no suggestion or motivation to make the proposed modification. Further, the proposed modification cannot change the principle operation of a reference.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established because Zastrow et al. *teach away* from the presently claimed subject matter. Further, Applicants submit that there is no motivation to modify Maor et al. or Shiga Yoko with Zastrow et al. to arrive at the presently claimed subject matter, because doing so would change the principle operation of Zastrow et al.

Independent claim 1 is directed to a cosmetic preparation for topical application onto skin of a subject, the preparation consisting of: Dead Sea mud; demagnetized nanoparticles dispersed therein and present in an amount of 1 to 20 wt%, the demagnetized nanoparticles being suitable for magnetization when applied to the skin of the subject; and optionally one or more cosmetically acceptable additives. Claims 3, 5, 6, 8, 11 and 12 depend, either directly or indirectly from claim 1.

In contrast to the presently claimed subject matter, Maor et al is directed to a pharmaceutical cream composition for topical application for the treatment of skin disorders and skin diseases, comprising 1-6 wt% Dead Sea Mud as an active ingredient. See Maor et al. at the abstract.

Zastrow et al. is directed to cosmetic and dermatological preparation for treating sensitive tissue, wounds and hair that contain magnetically hard particles such as barium or strontium hexaferrite single crystals, samariumcobalt particles (SmCo) and neodymium-iron-boron particles. See Zastrow et al. at the abstract.

Shiga Yoko is directed to magnetic cosmetic compositions for improving blood flow. See Shiga Yoko at the abstract.

A. Teaching Away

Applicants respectfully submit that Zastrow et al. *teach away* from the presently claimed subject matter. Specifically, Applicants submit that ***Zastrow et al. require lamellar aggregates be present in an amount of at least 2.5 wt %, based on the total composition in order to operate. See Zastrow et al. at column 2, lines 17-22. However, in complete contrast, the presently claimed subject matter cannot include lamellar aggregates present in any amount.***

Applicants note that independent claim 1 has been amended to recite the closed ended transition language “consisting of.” In view of this transition language, as well as the elements recited in claim 1, Applicants submit that lamellar aggregates are not present in the claimed subject matter. As Zastrow et al. expressly indicate that lamellar aggregates must be present in the amount specified, a skilled artisan would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant. Accordingly, Applicants submit that, as set forth by the court in *In re Gurley*, Zastrow et al. *teach away* from the presently claimed subject matter.

B. No Motivation to Modify

In addition to teaching away from the presently claimed subject matter, Applicants submit that there is no motivation to modify the cited references to achieve the presently claimed subject matter as doing so would destroy the principle operation of Zastrow et al. and the a proposed modification would render Zastrow et al. unsatisfactory for its intended purpose.

As discussed, Applicants submit that that ***Zastrow et al. require lamellar aggregates be present in an amount of at least 2.5 wt %***, based on the total composition in order to operate. See Zastrow et al. at column 2, lines 17-22. However, in complete contrast, ***the presently claimed subject matter cannot include lamellar aggregates present in any amount.***

Again, Applicants note that independent claim 1 has been amended to recite the closed ended transition language “consisting of.” In view of this transition language, as well as the elements recited in claim 1, Applicants submit that lamellar aggregates cannot be present in the claimed preparation. As Zastrow et al. expressly indicate that lamellar aggregates must be present in order to operate, Applicants submit that there is no motivation to modify the cited references because doing so would destroy the principle operation of Zastrow et al. and the a proposed modification would render Zastrow et al. unsatisfactory for its intended purpose

In view of the remarks set forth herein, it is submitted that, whether taken alone or in combination, none of the cited references render claims 1, 3, 5, 6, 8, 11 and 12 obvious within the meaning of 35 USC § 103(a). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

VI. New Claim 18

Claim 18 has been newly added. As discussed, new claim 18 is directed the cosmetic preparation according to claim 3, wherein the demagnetized nanoparticles are demagnetized strontium hexaferrite nanoparticles.

Applicants respectfully submit that new claim 18 is novel and non-obvious for at least the reason that it depends from independent claim 1, which is also novel and non-obvious for the reasons set forth herein above. Accordingly, Applicants respectfully request an indication that all of the pending claims are now allowable.

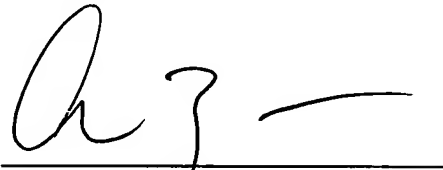
CONCLUSION

In view of the foregoing, Applicant submits that the application is in condition for immediate allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'ahj' followed by a horizontal line.

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